

## **REMARKS**

The following Remarks are in reply to the Office Action mailed July 3, 2007. Claims 1-61 were pending in the Application prior to the outstanding Office Action. The Examiner is thanked for conducting an extensive interview with the Applicant on Monday September 17, 2007 at 6 PM EST (3 PM PST). Based on the interview the Applicant has tried to simplify the language of Claim 1 in order to reflect that the claim is inherently supported by the specification.

Claims 1, 15, 20 and 41 have been amended. The amendments to Claims 1, 20 and 41 are supported in the application as originally filed at paragraphs [0021]-[0027]. Claims 1-61 remain for the Examiner's consideration. Reconsideration and withdrawal of the rejections are respectfully requested.

## **CLAIM OBJECTIONS**

The Examiner objects to the word 'and' in Claim 15.

The Applicants thank the Examiner for her especially careful reading of the claim and amends the claim as suggested by the Examiner.

## **CLAIM REJECTIONS UNDER 35 U.S.C. § 112**

Claims 1-19 are rejected under 35 U.S.C. §112 first paragraph as failing to comply with the written description requirement.

The Applicants believe the steps of claim 1 do meet the written description requirement since according to paragraph [0026] a comment is always linked to an anchor or a connector and a link always identifies two existing anchors. When the algorithm begins no anchors exist, so neither a comment nor a link are possible alternatives. Thus the first categorized annotation must implicitly be an anchor. Once the first anchor has been categorized then the implicit alternatives are either a second anchor or a comment. Because a person having ordinary skill in the art would understand that the limitations explicitly disclosed in paragraphs [0021]-[0027] implicitly limit the algorithm, the Applicant has met the written description requirement.

The Applicants respectfully request that the Examiner reconsider the 35 U.S.C. §112 first paragraph rejection.

### CLAIM REJECTIONS UNDER 35 U.S.C. § 112

Claims 1-19 are rejected under 35 U.S.C. §112 second paragraph as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicants believes the specification has particularly pointed out and distinctly claimed the subject matter of the invention. For example, according to paragraph [0021] the state machine initially always tries to interpret a stroke as an anchor or a link. Because a person having ordinary skill in the art would understand that the limitations explicitly disclosed in paragraphs [0021]-[0027] implicitly limit the algorithm, the Applicant has particularly pointed out and distinctly claimed the subject matter of the invention.

The Applicants respectfully request that the Examiner reconsider the 35 U.S.C. §112 second paragraph rejection.

### CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-61 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable *Marshall*, U.S. Patent App. No. 2003/0070139 (hereinafter '*Marshall*').

Amended Claims1 includes the limitation "categorizing a first annotation where the first categorized annotation is an anchor, wherein the anchor intersects a word or an image in the digital document". *Marshall* does not teach or suggest that the first annotation must be an anchor or that an anchor intersect, cross or touch with a region of the text or an image (e.g., a word search of *Marshall* reveals no occurrences of the words 'intersect', 'cross', 'touch' or 'region'). Since *Marshall* does not teach or suggest that the first annotation type must be an anchor type or that the anchor type must intersect a word or an image it does not teach or suggest all limitations of the amended claim.

Amended Claims 20 and 41 include the limitation "wherein the processor first categorizes a freeform annotations as a first anchor type, wherein the first anchor type intersects a word or an image in the digital document". *Marshall* does not teach or suggest that the first annotation must be an anchor or that an anchor intersect, cross or touch with a region of the text or an image (e.g., a word search of *Marshall* reveals no occurrences of the words 'intersect', 'cross', 'touch' or 'region'). Since *Marshall* does not teach or suggest that the first annotation type must be an anchor type or that the anchor type must intersect a word or an image it does not

teach or suggest all limitations of the amended claim. MPEP 2143.03 As such Claim 1 was not obvious at the time the invention was made.

Claims 2-19, 21-40 and 42-61 all directly or indirectly depend from independent Claims 1, 20 and 41, and are therefore believed patentable for at least the same reasons as the independent Claims 1, 20 and 41 and because of the additional limitations of these claims.

## CONCLUSION

In light of the above, it is respectfully requested that all outstanding rejections be reconsidered and withdrawn. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge the required fees and any underpayment of fees or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this reply, including any fee for extension of time, which may be required.

Respectfully submitted,

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